



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,705	07/29/2004	Toshiyasu Abe	OPAS11004	4704
25315 7590 09/18/2008 BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			EXAMINER WEST, THOMAS C	
			ART UNIT 3685	PAPER NUMBER
			MAIL DATE 09/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/710,705	Applicant(s) ABE, TOSHIYASU	
	Examiner THOMAS WEST	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 36, 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply the Request for Continued Examination filed on 9-4-08.
Claims 1-37 are currently pending and have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new grounds of rejection.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 36, 37 recite "predefined amount", which has no support in the specification.

Claim Rejections - 35 USC §101

4. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-12, 24-35, 36 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 3685

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, claims 1, 24, 36 and their dependent claims 2-12, 25-35 lack sufficient technology. (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. The term "portion" in claims 36, 37 is a relative term which renders the claim indefinite. The term "portion" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3685

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5-11, 13-15, 17-26, 28-37 are rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6, 233,682 ("Fritsch"), in view of Karaoguz, US Patent Application No. 2004/0117306.

Claims 1, 13, 24:

Downs, as shown, discloses authorizing purchaser and distributing a portion of sale to registered entities associated with any certain works that were copied (see at least column 2, lines 35-39).

Downs discloses the limitations as shown above. Downs does not directly disclose a purchaser of a medium or recording on the medium, but Fritsch teaches (see at least column 4, lines 16-19, column 5, lines 58-65, column 5, lines 66-67 and column 6, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the purchasing and recording of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website as well as purchase the media for doing so on the same website and authorize copying after a purchase to insure no illegal copies are made and for the convenience of producing copies from a kiosk.

Art Unit: 3685

Downs/Fritsch discloses the limitations as shown above. Downs/Fritsch does not directly disclose purchasing a recording medium... wherein certain works are not purchased or authorization to copy made after purchase of the recording media, but Karaoguz does (paragraph 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs/Fritsch to include free content along with a purchased medium, since the user experience is enhanced by paying one fee for the entire content which is incorporated into buying the media.

Claims 2, 3, 14, 15, 25, 26:

Downs, as shown, discloses recoding media (see at least column 4, lines 1-3).

Claims 5, 6, 17, 18, 28, 29:

Downs, as shown, discloses a unique identifier (see at least column 22, lines 9-13).

Claims 7, 19:

Downs, as shown, discloses authorizing purchaser (see at least column 7, lines 56-65).

Claims 8, 20:

Art Unit: 3685

Downs, as shown, discloses retrieve works from a database and store them on a medium (see at least column 19, steps 138, 143).

Claims 9, 21:

Downs, as shown, discloses receiving identifier, purchaser information, and award (see at least column 22, lines 9-13, column 75, lines 20-22, column 45 lines 53-60, column 75, lines 1-20).

Claims 10, 11, 22, 23, 34, 35:

Downs, as shown, discloses registered entities (see at least column 9, lines 27-32).

Claims 30, 33:

Downs, as shown, discloses data entry, identifier, authorization (see at least column 75, lines 1-20, column 75, lines 51-67, column 10, lines 50-60, column 11, lines 40-48).

Claim 31:

Downs discloses the limitations as shown above. Downs further discloses a database and approved identifier (see at least column 9, lines 5-7, column 11, lines 40-48). Downs does not directly disclose a blank medium, but Fritsch teaches (see at least column 4, lines 16-19, column 5, lines 58-65).

Art Unit: 3685

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the blank medium of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website.

Claim 32:

Downs, as shown, discloses a webpage and database (see at least column 75, lines 1-20).

Claims 36, 37:

Downs discloses the limitations as shown above. Downs further discloses registered entities and distributing a portion of the predefined amount of compensation to registered entities associated with any certain works that were copied (see at least column 2, lines, lines 35-39, column 9, lines 27-32). Downs does not directly disclose distributing a recording medium or a predefined amount of compensation, but Fritsch teaches this (see at least column 4, lines 16-19, column 5, lines 58-65). Fritsch teaches, authorization to copy is made after purchase of the recording media (see column 5, lines 66-67 and column 6, lines 1-19. Fritsch further teaches a predetermined percentage (see column 7, lines 46-49)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include the recording medium and authorization

Art Unit: 3685

to copy after purchase of media and predetermined percentage of Fritsch since this allows the consumer, for example, to buy the rights to copy music as well as purchase the media for doing so on the same website and authorize copying after a purchase to insure no illegal copies are made and for the convenience of producing copies from a kiosk and also to establish a predetermined percentage for royalty payments since this is both typical and necessary in creating a binding contract between distributor and artist.

10. Claim 12 is rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6, 233,682 ("Fritsch"), in view of Karaoguz, US Patent Application No. 2004/0117306, in further view of Schneier, US Patent Application No. 2003/0177347 ("Schneier").

Claim 12:

Downs/Fritsch/Karaoguz disclose the limitations as shown above.

Downs/Fritsch do not directly disclose a charitable organization, but Schneier teaches (see at least paragraph 465).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs/Fritsch/Karaoguz to include the charitable organization of Schneier since this allows an artist or author to a portion of revenues to a charity of their choice.

Art Unit: 3685

11. Claims 4, 16, 27 are rejected under U.S.C. 103(a) as being unpatentable over Downs et al., US Patent No. 6,226,618 ("Downs ") in view of Fritsch, US Patent No. 6,233,682 ("Fritsch"), in view of Karaoguz, US Patent Application No. 2004/0117306 and in further view of Ferandez-Molina, The Moral Rights of Authors in the Age of Digital Information ("Ferandez").

Claims 4, 16, 27:

Downs/Fritsch/Karaoguz disclose the limitations as shown above.

Downs/Fritsch do not directly disclose a written authorization Ferandez teaches (see at least page 113, column 2, paragraph 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs/Fritsch/Karaoguz to include the written authorization of Ferandez since this provides the customer with authorization to copy an artistic work.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on M-R 7:30am - 5pm EST, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3685
September 10, 2008

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685